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| Date: November 22, 2005         | Phone Number | Fax Number     |
| To: Patent Appeal Briefs, USPTO |              | (571) 273-8300 |
| From: Kevin J. Zilka            |              |                |

Docket No.: SVIPGP002B

App. No: 10/661,878

Total Number of Pages Being Transmitted, Including Cover Sheet: 34

**Message:**

Please deliver to the Board of Patent Appeals.

Thank you,

Kevin J. Zilka

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November 21, 2005

NOV 22 2005

## 3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

small entity \$250.00

Appeal Brief fee due \$250.00

## 4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

## 5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$250.00  
Extension fee (if any) \$0.00

TOTAL FEE DUE \$250.00

## 6. FEE PAYMENT

Authorization is hereby made to charge the amount of \$250.00 to Deposit Account No. 50-1351 (Order No. SVIPGP002B).

A duplicate of this transmittal is attached.

## 7. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1351 (Order No. SVIPGP002B).

Reg. No.: 41,429  
Tel. No.: 408-971-2573  
Customer No.: 28875

Signature of Practitioner  
Kevin J. Zilka  
Zilka-Kotab, PC  
P.O. Box 721120  
San Jose, CA 95172-1120  
USA

Transmittal of Appeal Brief--page 2 of 2



Practitioner's Docket No. SVIPGP002B

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kevin J. Zilka et al.

Application No.: 10/661,878

Group No.: 3629

Filed: 09/11/2003

Examiner: Mooneyham, J.

For: SYSTEM, METHOD AND COMPUTER PROGRAM PRODUCT FOR COLLECTING  
STRATEGIC PATENT DATA ASSOCIATED WITH AN IDENTIFIERMail Stop Appeal Briefs – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEF  
(PATENT APPLICATION--37 C.F.R. § 41.37)

1. Transmitted herewith is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on November 21, 2005.
2. STATUS OF APPLICANT

This application is on behalf of a small entity. A statement was already filed.

## CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*

*(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)*

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37 C.F.R. § 1.10\*

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Erica L. Farlow

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\* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Transmittal of Appeal Brief--page 1 of 2

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Practitioner's Docket No. SVIPGP002B

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kevin J. Zilka et al.

Application No.: 10/661,878

Group No.: 3629

Filed: 09/11/2003

Examiner: Mooneyham, J.

For: SYSTEM, METHOD AND COMPUTER PROGRAM PRODUCT FOR COLLECTING  
STRATEGIC PATENT DATA ASSOCIATED WITH AN IDENTIFIER

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37 C.F.R. § 1.8(a)

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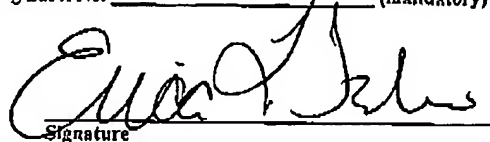
37 C.F.R. § 1.10\*

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Erica L. Farlow

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\* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Transmittal of Appeal Brief--page 1 of 2

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|                             |                 |
|-----------------------------|-----------------|
| small entity                | \$250.00        |
| <b>Appeal Brief fee due</b> | <b>\$250.00</b> |

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Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

## 5. TOTAL FEE DUE

The total fee due is:

|                        |                 |
|------------------------|-----------------|
| Appeal brief fee       | \$250.00        |
| Extension fee (if any) | \$0.00          |
| <b>TOTAL FEE DUE</b>   | <b>\$250.00</b> |

## 6. FEE PAYMENT

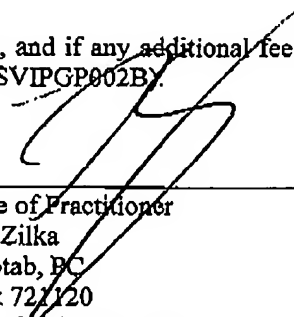
Authorization is hereby made to charge the amount of \$250.00 to Deposit Account No. 50-1351 (Order No. SVIPGP002B).

A duplicate of this transmittal is attached.

## 7. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1351 (Order No. SVIPGP002B).

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Tel. No.: 408-971-2573  
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\_\_\_\_\_  
Signature of Practitioner  
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P.O. Box 721120  
San Jose, CA 95172-1120  
USA

Transmittal of Appeal Brief--page 2 of 2

NOV 22 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of )  
Kevin J. Zilka et al. ) Examiner: Mooneyham, J.  
Application No. 10/661,878 ) Art Unit: 3629  
Filed: March 31, 2003 ) Docket No. SVIPGP002B  
For: SYSTEM, METHOD AND COMPUTER ) Date: November 22, 2005  
PROGRAM PRODUCT FOR COLLECTING )  
STRATEGIC PATENT DATA )  
ASSOCIATED WITH AN IDENTIFIER )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**ATTENTION: Board of Patent Appeals and Interferences**

**APPEAL BRIEF (37 C.F.R. § 41.37)**

This brief is in furtherance of the Notice of Appeal, filed in this case on November 21, 2005.

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)(i)):

- I REAL PARTY IN INTEREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS
- V SUMMARY OF CLAIMED SUBJECT MATTER
- VI GROUNDS OF REJECTION PRESENTED FOR REVIEW
- VII ARGUMENTS
- VIII APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

- 2 -

**IX APPENDIX LISTING ANY EVIDENCE RELIED ON BY THE APPELLANT IN THE  
APPEAL**

The final page of this brief bears the practitioner's signature.

- 3 -

**I REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))**

The real parties in interest in this appeal are Kevin J. Zilka and Dominic M. Kotab.



- 4 -

## **II RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c) (1)(ii))**

With respect to other prior or pending appeals, interferences, or related judicial proceedings that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no other such appeals, interferences, or related judicial proceedings.

Since no such proceedings exist, no Related Proceedings Appendix is appended hereto.

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### **III STATUS OF CLAIMS (37 C.F.R. § 41.37(c) (1)(iii))**

#### **A. TOTAL NUMBER OF CLAIMS IN APPLICATION**

Claims in the application are: 1-2, 4-13, 18-20 and 44-45

#### **B. STATUS OF ALL THE CLAIMS IN APPLICATION**

1. Claims withdrawn from consideration: None
2. Claims pending: 1-2, 4-13, 18-20 and 44-45
3. Claims allowed: None
4. Claims rejected: 1-2, 4-13, 18-20 and 44-45

#### **C. CLAIMS ON APPEAL**

The claims on appeal are: 1-2, 4-13, 18-20 and 44-45

See additional status information in the Appendix of Claims.

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**IV STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))**

As to the status of any amendment filed subsequent to final rejection, there are no such amendments.

- 7 -

**V SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))**

With respect to a summary of Claim 1 et al., as shown in Figures 3, 8, 11, 13, 14 15 et al., a computer program product or computer readable medium is provided for organizing patents utilizing a computer-implemented system is provided. In use, a notes field is displayed for receiving manually entered notes including text and the manually entered notes are stored in association with at least one identifier, thus associating the manually entered notes with the at least one identifier (e.g. item 808 of Figure 8 and Figure 11 and item 1100 of Figure 11). The manual selection of a file is allowed and the manually selected file is stored in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents (e.g. item 804 of Figure 8 and item 1100 of Figure 11). In addition, a plurality of patents are associated with the at least one identifier (e.g. item 1100 of Figure 11). Still yet, the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier (e.g. item 1500 of Figure 15). Furthermore, a set of patents is reported by displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface (e.g. item 1300 in Figure 13), by displaying statistics regarding a number of the patents of the set in each category of technology, by displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology, and by displaying second additional information associated with at least one of the patents of the list upon the selection of an additional icon, where the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure (e.g. item 1400 of Figure 14), and where the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface. Furthermore, the notes and at least one of the files are made accessible to other parties utilizing e-mail and the method is, at least in part, carried out utilizing

- 8 -

the computer-implemented system. Note the description of Figures 3, 8, 11, 13, 14 15 et al. between pages 7-33, for example.

With respect to a summary of Claim 19, the summary of Claim 1 et al. is incorporated herein by reference, at least in part, except that Claim 19 is directed to a method claim.

With respect to a summary of Claim 20, the summary of Claim 1 et al. is incorporated herein by reference, at least in part, except that Claim 20 is directed to a system claim.

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**VI GROUNDS OF REJECTION PRESENTED FOR REVIEW (37 C.F.R. § 41.37(c)(1)(vi))**

Following, under each issue listed, is a concise statement setting forth the corresponding ground of rejection.

Issue #1: The Examiner has rejected Claims 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 112, second paragraph, as being indefinite.

Issue #2: The Examiner has rejected Claims 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 101 as being directed toward non-statutory subject matter.

Issue #3: The Examiner has rejected Claims 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (U.S. Patent Application Publication No. 2003/0046307).

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**VII ARGUMENTS (37 C.F.R. § 41.37(c)(1)(vii))**

The claims of the groups noted below do not stand or fall together. In the present section, appellant explains why the claims of each group are believed to be separately patentable.

**Issue #1:**

The Examiner has rejected Claims 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 112, second paragraph, as being indefinite.

*Group #1: Claims 1-2, 4, 7, 10-11, 13, 18-20 and 44-45*

In the latest response dated 10/11/2005, the Examiner has maintained his 35 U.S.C. 112 rejection of all of the claims.

First, the Examiner has stated that appellant's claimed "storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier" is unclear. Appellant respectfully asserts that such language is clear in that what is claimed is the storing of a manually selected file in a manner such that the file is associated with at least one identifier.

Second, the Examiner has stated that the word "accessible" in appellant's claimed technique "wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier," is unclear. In response, appellant points out the plain and ordinary meaning of the term "accessible," which is evidenced by the exemplary definition set forth hereinbelow:

ac·ces·si·ble      adj. "Easily obtained"

*The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company.  
Published by Houghton Mifflin Company. All rights reserved.*

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Thus, clearly appellant claims that the manually entered notes, at least one of the manually selected files, and the patents are capable of being easily obtained by way of a subsequent selection of the at least one identifier.

Third, the Examiner has stated that it is unclear what the word "reported" means in appellant's claimed technique "wherein a set of patents is reported." However, appellant specifically claims how such patents are reported in the following claim language:

"displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface,  
displaying statistics regarding a number of the patents of the set in each category of technology,  
displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology,  
displaying second additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure,  
wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface."

Fourth, the Examiner states that it is unclear what "made accessible" means in the context of appellant's claimed technique "wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail." In response, appellant again points out the plain and ordinary meaning of the term "accessible," which is evidenced by the exemplary definition set forth hereinabove. Thus, clearly appellant claims that the notes and at least one of the files are capable of being easily obtained by other parties utilizing email.



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Fifth, the Examiner has questioned what appellant means by “associating a plurality of patents with the at least one identifier.” Appellant respectfully asserts that such claim language is clear, in that what is claimed is a plurality of patents that are associated with, or in other words corresponding to, at least one identifier.

*Group #2: Claims 5 and 6*

The Examiner has stated that it is unclear what appellant means by the language: “the at least one identifier is determined utilizing an add icon” (see Claim 5) and “the at least one identifier is determined utilizing a modify icon” (see Claim 6). Appellant respectfully asserts that the at least one identifier that is associated with manually entered notes, the manually selected file, etc. (see independent Claim 1) is determined, or in other words identified, for making such associations utilizing an add/modify icon.

*Group #3: Claims 8 and 9*

The Examiner has stated that it is unclear what appellant means by “the file is selected utilizing a file structure field” (see Claim 8) and “the file structure field includes a file tree-structure” (see Claim 9). Appellant respectfully asserts that such “file structure field” and “file tree-structure” language is clearly a field for selecting a file where such field is in the form of a tree-structure (e.g. a tree of files that allows a file to be selected).

*Group #4: Claim 12*

The Examiner has stated that it is unclear what appellant means by “the patents associated with the at least one identifier are identified by searching a database of already existing identifiers.” Appellant respectfully asserts that such language clearly claims that patents are identified by searching a database of identifiers associated with patents.

Issue #2:

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The Examiner has rejected Claims 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 101 as being directed toward non-statutory subject matter.

Such rejection is deemed overcome by virtue of the amendments filed coincidently with the filing of the aforementioned notice of appeal.

Issue #3:

The Examiner has rejected Claims 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (U.S. Patent Application Publication No. 2003/0046307).

*Group #1: Claims 1-2, 4-13, 18 and 44-45*

In the latest Office Action dated 10/11/2005, it seems that the Examiner has simply reiterated his arguments made in the previous Office Action dated 10/11/2005.

The Examiner has again restated the argument that Appellant's arguments fail to comply with 37 CFR 1.111 (b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Appellant respectfully disagrees. Specifically, reiterated below are arguments (that were previously submitted, at least part), which clearly point out how the language of the claims patentably distinguishes them from the references, in specific terms of the claim language for which the Examiner has still not been able to make a specific prior art showing.

Appellant again further argues that many benefits arise from the synergy of the technology mapping, and the remaining claimed framework. Specifically, a user is capable of associating patents with at least one identifier (with additional notes associated therewith), and also obtaining technology-related metrics regarding a set of patents, with one framework that is more effectively organized. Specifically, only appellant teaches and claims such a drill-down

- 14 -

technique for accessing information relating to the patents subject to the technology mapping, which is believed to be unique, when taken in combination with the remaining claim elements.

In addition, the Examiner has again admitted in the latest Office Action dated 10/11/2005 that Rivette fails to explicitly disclose a technology mapping depicting at least one category of technology or wherein the first additional information includes a list of the patents of the set associated with one category of technology, or wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure, or wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface, or wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail; as claimed by appellant.

The Examiner goes onto simply dismiss such novel limitations as being nonfunctional descriptive material and not functionally involved in the acts or structure recited. The Examiner also argues that the data does not alter how the system functions or the acts are performed.

Appellant vehemently disagrees with the Examiner on this point. By requiring the very specifically claimed manner (i.e. separate interfaces, etc.) in which the acts are performed (i.e. separate icons, etc.), a significantly improved manner of organizing, displaying, and accessing patent-related information is achieved.

In addition, such language is functional in that it claims the specific manner in which a "set of patents is reported," as found in each of the independent claims. Thus, the set of patents is specifically reported by:

"displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface,"

"displaying statistics regarding a number of the patents of the set in each category of technology,"

- 15 -

“displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology,”

“displaying second additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure,”

“wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface” (see this or similar, but not identical, language in each of the independent claims, as amended).

Still yet, with respect the above independent claims, the foregoing arguments of the Examiner are further deemed ineffective, as each of the claims of the present group are computer program product or computer readable medium claims.

It appears that the excerpts from Rivette relied upon by the Examiner are deficient in numerous respects. For example, the Examiner relies on the following excerpts from Rivette to make a prior art showing of appellant's claimed “displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface, displaying statistics regarding a number of the patents of the set in each category of technology” (see this or similar, but not identical, language in each of the independent claims, as amended).

[0025] The processing automatically performed by the invention relates to (but is not limited to) patent mapping, document mapping, document/patent citation both forward and backward), document/patent aging, patent bracketing/clustering (both forward and backward), inventor patent count, inventor employment information, and finance. Other functions also fall within the scope of the invention.

[0262] For example, a patent's value may be linked to whether it covers technology that the corporation is currently using, or that the corporation may use in the future. For this and other purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with manufacturing information 208 and/or R & D information 206. Also, a patent's value may be linked to whether it has generated licensing revenue. For this and other

- 16 -

purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with the licensing information 214. Further, a patent's value may be linked to the degree of success of the corporation's commercial products related to the patent (i.e., the commercial embodiments of the patented technology). For this and other purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with the financial information 216.

[0277] FIG. 3 is a block diagram of a system 302 according to an embodiment of the invention. The system 302 includes a plurality of databases 316 that store patent information and other information, such as R & D (research and development) information, financial information, licensing information, manufacturing information, HR (human resources) information, and any other information that may be pertinent to the analysis of the patent information. The terms "database" and "table" are used synonymously herein."

After a careful review of such excerpt, however, it is clear that Rivette merely suggests linking value to a patent based on an associated technology. There is not even a suggestion, in such excerpt, of any sort of displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface (emphasis added), let alone displaying statistics regarding a number of the patents of the set in each category of technology (emphasis added), as claimed, in combination with the remaining claim elements.

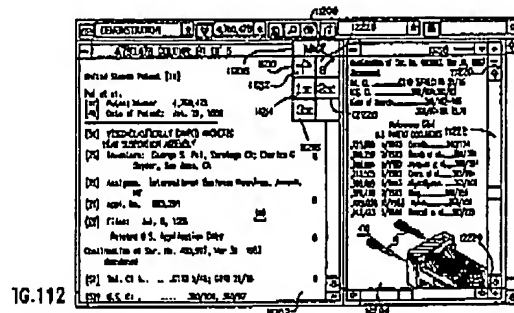
Further, the Examiner relies on the following excerpt from Rivette to make a prior art showing of appellant's claimed technique "wherein the first additional information includes a list of the patents of the set associated with one category of technology" (see this or similar, but not identical, language in each of the independent claims, as amended).

"[0331] Information on groups is stored in the group databases 621. Generally, a group is a data structure that includes any number of documents that typically follow a common theme or characteristic (although this is not a mandatory requirement of groups). More particularly, a group is a data structure that includes any number of patents that typically follow a common theme or characteristic (although, again, this is not a mandatory requirement of groups). Groups are document-centric, or in many cases, patent-centric."

After a careful review of such excerpt, however, it is clear that Rivette merely links value to a patent based on a technology. There is not even a suggestion, in such excerpt, of any sort of first additional information (that is displayed upon the selection of an icon, as claimed) including a list of the patents of the set associated with one category of technology (emphasis added), as claimed, in combination with the remaining claim elements.

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Still yet, the Examiner relies on the following figure from Rivette to make a prior art showing of appellant's claimed technique "wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface" (see this or similar, but not identical, language in each of the independent claims, as amended).



As mentioned earlier, Rivette fails to even suggest appellant's claimed appellant's statistics and first additional information, as claimed, and thus can simply not meet the present claim language incorporating the same. There is not even a suggestion, in the cited excerpt, of any sort of statistics (as claimed) displayed in a first interface, first additional information (as claimed) is displayed in a second interface separate from the first interface, and the second additional information (as claimed) is displayed in a third interface separate from the first interface and the second interface (emphasis added), as claimed, in combination with the remaining claim elements.

Furthermore, in the latest Office Action dated 10/11/2005, the Examiner has argued that the first element of the prima facie case of obviousness has been met because the motivation came from the knowledge generally available to one of ordinary skill in the art. Appellant respectfully points out the arguments made hereinabove which clearly show that appellant's claim language would not have been obvious in view of the Rivette reference.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on appellant's disclosure. *In re Vaecht*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Appellant respectfully asserts that at least the first and third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest *ALL* the claim limitations, and in view of the advantages associated with such novel claim limitations. Again, a notice of allowance or a specific prior art showing of all of appellant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

In view of the remarks set forth hereinabove, all of the independent claims are deemed allowable, along with any claims depending therefrom.

*Group #2: Claim 19*

With respect to the present grouping, appellant incorporates the above arguments from Group #1, as well as points out that the present claim is a method claim and thus the appropriate law and rules should be applied accordingly.

*Group #3: Claim 20*

With respect to the present grouping, appellant incorporates the above arguments from Group #1, as well as points out that the present claim is a system claim and thus the appropriate law and rules should be applied accordingly.

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**VIII APPENDIX OF CLAIMS (37 C.F.R. § 41.37(c)(1)(viii))**

The text of the claims involved in the appeal (along with associated status information) is set forth below:

1. (Previously Presented) A computer program product embodied on a computer readable medium for organizing patents utilizing a computer-implemented system, comprising:
  - computer code for displaying a notes field for receiving manually entered notes including text;
  - computer code for storing the manually entered notes in association with at least one identifier, thus associating the manually entered notes with the at least one identifier;
  - computer code for allowing the manual selection of a file;
  - computer code for storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents; and
  - computer code for associating a plurality of patents with the at least one identifier; wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier; wherein a set of patents is reported using:
    - computer code for displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface,
    - computer code for displaying statistics regarding a number of the patents of the set in each category of technology,
    - computer code for displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology,
    - computer code for displaying second additional information associated with at least one of the patents of the list upon the selection of an additional icon,



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wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure,

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface;

wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail.

2. (Previously Presented) The computer program product of claim 1, wherein the at least one identifier is determined by selecting an already-existing identifier.
3. (Cancelled)
4. (Previously Presented) The computer program product of claim 1, wherein the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu.
5. (Previously Presented) The computer program product of claim 1, wherein the at least one identifier is determined utilizing an add icon.
6. (Previously Presented) The computer program product of claim 1, wherein the at least one identifier is determined utilizing a modify icon.
7. (Previously Presented) The computer program product of claim 1, wherein the notes field allows a user to cut and paste notes.
8. (Previously Presented) The computer program product of claim 1, wherein the file is selected utilizing a file structure field.
9. (Previously Presented) The computer program product of claim 8, wherein the file structure field includes a file tree-structure.

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10. (Previously Presented) The computer program product of claim 8, wherein the file structure field allows a user to browse various folders where files have been previously stored.

11. (Previously Presented) The computer program product of claim 8, wherein the file structure is displayed simultaneously with the notes field on the same interface.

12. (Previously Presented) The computer program product of claim 1, wherein the patents associated with the at least one identifier are identified by searching a database of already existing identifiers.

13. (Original) The computer program product of claim 12, wherein the database is a comprehensive database of all patents issued by at least one government agency.

14 – 17. (Cancelled)

18. (Previously Presented) A computer readable medium encoded with an intellectual property data structure for realizing the function of organizing and reporting information associated with an identifier, comprising:

- an identifier object;

- a notes object correlated with the identifier object for tracking manually entered notes including text associated with the identifier object;

- at least one file object correlated with the identifier object by providing a correspondence between the file object and the identifier object, for tracking manually selected files associated with the identifier object, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents; and

- at least one patent object correlated with the identifier object for tracking a plurality of related patent identifiers associated with the identifier object;

- wherein a set of patents is reported utilizing the computer readable medium with:

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computer code for displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface,

computer code for displaying statistics regarding a number of the patents of the set in each category of technology,

computer code for displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology,

computer code for displaying second additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure,

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface;

wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail.

19. (Previously Presented) A method for organizing patents utilizing a computer-implemented system, comprising:

displaying a notes field for receiving manually entered notes including text;

storing the manually entered notes in association with at least one identifier, thus associating the manually entered notes with the at least one identifier;

allowing the manual selection of a file;

storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents; and

associating a plurality of patents with the at least one identifier;

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wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier;

wherein the notes field allows a user to cut and paste notes;

wherein the file is selected utilizing a file structure field including a file tree-structure that allows a user to browse various folders where files have been previously stored, where the file structure is displayed simultaneously with the notes field on the same interface, the file selected utilizing the file tree-structure including information from a source separate from the patents;

wherein the patents associated with the at least one identifier are identified by searching a database including a comprehensive database of all patents issued by at least one government agency;

wherein a set of patents is reported by:

displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface,

displaying statistics regarding a number of the patents of the set in each category of technology,

displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology,

displaying second additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure,

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface;

wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail;

wherein said method is carried out utilizing the computer-implemented system including computer code embodied on a computer readable medium.

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20. (Previously Presented) A system including a computer readable medium for organizing patents, comprising:

- computer code for displaying a notes field for receiving manually entered notes including text;

- computer code for storing the manually entered notes in association with at least one identifier, thus associating the manually entered notes with the at least one identifier;

- computer code for allowing the manual selection of a file, wherein the file is selected utilizing a file structure field including a file tree-structure that allows a user to browse various folders where files have been previously stored, where the file structure is displayed simultaneously with the notes field on the same interface, the file including information from a source separate from the patents;

- computer code for storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents; and

- computer code for associating a plurality of patents with the at least one identifier; wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier;

- wherein a set of patents is reported with computer code for:

- displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface,

- displaying statistics regarding a number of the patents of the set in each category of technology,

- displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology,

- displaying second additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second

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additional information includes a patent number, a status, an exemplary claim, and an exemplary figure,

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface;

wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail.

21. - 43. (Cancelled)

44. (Previously Presented) A computer readable medium encoded with an intellectual property data structure for realizing the function of organizing and reporting information associated with an identifier, comprising:

an identifier object;

a notes object correlated with the identifier object for tracking manually entered notes including text associated with the identifier object; and

at least one patent object correlated with the identifier object for tracking a plurality of related patent identifiers associated with the identifier object;

wherein a set of patents is reported utilizing the computer readable medium with:

computer code embodied on the computer readable medium for displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface,

computer code embodied on the computer readable medium for displaying statistics regarding a number of the patents of the set in each category of technology,

computer code embodied on the computer readable medium for displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology, and

computer code embodied on the computer readable medium for displaying second additional information associated with at least one of the patents of the list

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upon the selection of an additional icon, where the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure;

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface;

wherein the notes are made accessible to other parties.

45. (Previously Presented) A computer readable medium encoded with an intellectual property data structure for realizing the function of organizing and reporting information associated with an identifier, comprising:

an identifier object;

a notes object correlated with the identifier object for tracking manually entered notes including text associated with the identifier object;

at least one file object correlated with the identifier object by providing a correspondence between the file object and the identifier object, for tracking manually selected files associated with the identifier object; and

at least one patent object correlated with the identifier object for tracking a plurality of related patent identifiers associated with the identifier object;

wherein a set of patents is reported utilizing the computer readable medium with:

computer code embodied on the computer readable medium for displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface,

computer code embodied on the computer readable medium for displaying statistics regarding a number of the patents of the set in each category of technology,

computer code embodied on the computer readable medium for displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology, and

computer code embodied on the computer readable medium for displaying second additional information associated with at least one of the patents of the list

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upon the selection of an additional icon, where the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure; wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface.



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**IX APPENDIX LISTING ANY EVIDENCE RELIED ON BY THE APPELLANT  
IN THE APPEAL (37 C.F.R. § 41.37(c)(1)(ix))**

There is no such evidence.

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In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. SVIPG002B).

Respectfully submitted,

By:  \_\_\_\_\_

Kevin J. Zilka

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